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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,841	03/23/2004	Narito Goto	KOY-30	4250

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EXAMINER	
CHEA, THORL	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/806,841	GOTO, NARITO	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *1-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-37* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25, drawn to a photothermographic imaging material , classified in class 430, subclass 543.

II. Claims 26-37, drawn to an article , classified in class 430, subclass 332.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, the invention of group I and Group contains different type of dyes, Group I contains a dye forming by a color developing agent and color coupler, whereas group I is a cyan leuco dye.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Lucas on June 23, 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 26-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Claim 28 is objected to because of the following informalities: see line 7 which use " .The". Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 16-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Biavasco et al (US Patent No. 5,330,864), Fukui et al (US 2002/0102502) and Cerquone et al (US Patent No. 4,021,240) .

Biavasco et al discloses a photothermographic material substantially as claimed. See the abstract wherein the material comprises silver source material, light sensitive silver halide in catalytic proximity to said silver source material, binder and a chromogenic cyan leuco dye. The use of chemical sensitizer such as sulfur or selenium to chemically sensitize the silver halide emulsion is shown in column 14, lines 11-59; the organic silver salt which is can be used is a silver salt which is a comparatively stable to light, but form silver image when heated to 80 °C of higher in the presence of an exposed photocatalyst such s silver halide and reducing agent is shown in column 12, lines 59-69. Fukui et al disclose a phenol compound as reducing agent for silver salt of an organic acid in column 2, formula (I), (II) in the abstract and pages 3-4 compound 1-1 to 1-20, the silver halide grains having grain size of 0.01 micron to 1.15 micron in on page 13, [0099]; the binder having glass transition temperature of 10 °C to 80 °C on pages 13, [0132]; and the amount of an organic salt in an amount of 0.1 to 5 g/m^2 on page 13, [0095]; the surfactants and hydrazine compound on page 37, development accelerator-1 and compound F-1 to F-8. Cerquone et al in column 6, lines 30-69 discloses the a reducing

agent for organic silver to produce a desired dye in the imagewise exposed area of the photothermographic element. It disclosed that "it is believed that the reducing agent react with silver salt oxidizing agent in the element of this invention to produce a desired dye in the imagewise exposed area of the photothermographic element. It is believed that the latent image silver produced upon imagewise exposure catalyses the reaction between the reducing agent and the silver oxidizing agent.".

The invention discloses in Biavasco et al differs form that of the present claimed invention in its failure to disclose the use of the reducing agent and the phenol compound of formula (YA) claimed in the present claimed invention, but the compound YA and the reducing agent has been known as reducing agent for organic silver salt such as taught in Fukui et al. Moreover, it has been known to use the reducing agent in color photothermographic material to produce a desired dye in the imagewise exposed area such as taught in Cerquone et al. It would have been therefore obvious to the worker of ordinary skill in the art at the time the invention was made to include the reducing agents taught in Fukui et al in the material of Biavasco et al with an expectation of producing produce a desired dye in the imagewise exposed area of the photothermographic element, and thereby provide the invention as claimed.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the

international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 26-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Kashiwagi et al (US 2004/0106074).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See Kasiwagi et al pages 132-136, claims 139, especially claim 67, 33-39.

10. Claims 26-37 is rejected under 35 U.S.C. 102(e) as being anticipated by Kashiwagi et al (US 2004/0115569A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Kashiwagi et al disclose a photothermographic of the claimed invention. See pages 68-69 claims 1-10.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 27-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 33-39 of copending Application No. 10/718,295. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the reducing agent claimed in the copending application wholly encompasses the scope of the bisphenol reducing agent claimed in the present invention. The scope of the invention claimed in the copending application wholly encompasses the scope of the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 27-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/727,313. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the invention claimed in the copending application wholly encompasses the scope of the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

14. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea
June 23, 2005

Thorl Chea
Primary Examiner
Art Unit 1752